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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,201	07/11/2001	Eugene de Juan JR.	56247 (71699)	1217

21874 7590 06/23/2003

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EXAMINER

DEMILLE, DANTON D

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 06/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

Office Action Summary	Application No.	Applicant(s)	
	09/904,201	JUAN ET AL.	
	Examiner	Art Unit	
	Danton DeMille	3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 102

Claim 9 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yamada et al. Yamada teaches an intraocular lens 12 including an insertion and injection device 28 comprising an outlet member. The deflated lens 12 is mounted to the outlet member and includes a self-sealing mechanism 14/16 in which the insertion and injection device is removably and sealingly received such that the insertion and injection device can be removably and sealingly received in the self-sealing mechanism repeatedly, column 5, lines 39-52.

Claim Rejections - 35 USC § 103

Claims 1-7 and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. in view of Sahatjian. Yamada appears silent with regard to whether or not the catheter 28 is shielded by an outer tube during the insertion process however; such is well within the realm of the artisan of ordinary skill. In this art it is well known to have an outer catheter tube which covers and supports the smaller inner tube that contain the working member of the operation. Protecting the human tissue and the lens itself during the process is a conventional consideration when inserting objects within the body. There is no unobviousness in using an outer member for covering and protecting the lens during the insertion process. Balloon catheters are routinely inserted inside and outer tubular member during the insertion process and the same provision would be true here as well. Manipulating the deflated lens within a small opening within the human body would require the same care. Sahatjian who teaches an outer member 30 that contains and protects the inner inflatable member exemplifies this function. It would have been obvious to one of ordinary skill in the art to modify Yamada to use a separate

outer tube around the inner inflatable member as taught by Sahatjian to protect the human tissue and protect and guide the inflatable member to its destination.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Michelson. Michelson teaches that haptics 20 can be added to the inflatable lens as desired. It would have been obvious to one of ordinary skill in the art to further modify Yamada to include haptics as taught by Michelson when it is desired to help secure the lens in place.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Yamada does teach each and every element recited in claim 9 including the self-sealing mechanism 14, 16. Yamada teaches column 5, lines 39-52, that "the bore of the tube 14 is spontaneously closed due to the auto-sealing property of the gel filler 16." Therefore Yamada anticipates the claimed invention.

Regarding claim 1, the only difference between the claimed invention and Yamada is the provision of using a separate outer tube for protecting and guiding the inner tube during the insertion process. Using telescoping tubes within catheters for inserting objects within the human body is not new and is well within the realm of the artisan of ordinary skill. Adding a separate outer tube designed to protect and guide the inner tubular member is not viewed as an inventive step. Sahatjian teaches such a convention.

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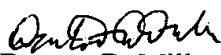
Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

ddd
19 June, 2003
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Danton DeMille
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Art Unit 3764